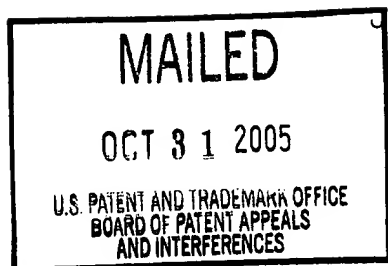


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI FUKUMOTO,
YUNICHI AIZAWA, and MUNEHISA TAKEDA



Appeal No. 2005-2186
Application No. 09/750,664

ON BRIEF

Before FRANKFORT, PATE, and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Hiroshi Fukumoto et al. appeal from the final rejection (mailed March 4, 2003) of claims 1-3. Claims 4-11, 17 and 18, the only other claims pending in the application, stand withdrawn from consideration.

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THE INVENTION

The invention relates to a liquid sprayer having particular utility in an inkjet print head. Representative claim 1 reads as follows:

1. A liquid sprayer comprising:
a liquid holder exposing a liquid surface of conductive liquid sprayed on an object; and
a field applicer forming an equipotential surface convexed with respect to the liquid surface of a conductive liquid sprayed on an object.

THE REJECTIONS

Claims 1-3 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

Claims 1-3 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,046,074 to Hochberg, deceased et al. (Hochberg).

Attention is directed to the main and reply briefs (filed November 3, 2003 and March 22, 2004) and answer (mailed January 21, 2004) for the respective positions of the appellants and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, second paragraph, rejection

The explanation of this rejection (see pages 3-6 in the answer) indicates that the examiner considers claims 1-3 to be indefinite because they (1) are narrative and replete with grammatical and idiomatic errors and fail to conform with current USPTO practice, and (2) contain a double inclusion of an element which, as disclosed, is common to the recited "liquid holder" and "field applier."

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

In the present case, the examiner has failed to advance any specific reasons or examples, and none are evident, to support the broad criticism that the appealed claims are narrative and replete with grammatical and idiomatic errors and fail to conform with current USPTO practice. Although the claims arguably might have been written in a form more acceptable to the examiner, this possibility, in and of itself, does not mean that the claims as currently constituted lack a reasonable degree of precision and particularity.¹

As for the alleged double inclusion, the mere fact that the "liquid holder" and "field applier" recited in the claims as separate elements might, as disclosed, share a common component, i.e., conductive nozzle plate 3, does not mean that the claims effectively require two such elements. One of ordinary skill in the art, reading the claims in light of the disclosure, clearly would understand this not to be the case. Properly construed, the claims do not involve any sort of double inclusion.

¹ At the oral hearing, the appellants' counsel, Mr. Ward, confirmed that the words --to be-- should appear before both occurrences of the word "sprayed" in claim 1 for consistency with the underlying disclosure. In the event of further prosecution, appropriate steps should be taken to implement these changes.

Thus, the examiner's position that claims 1-3 are indefinite is unfounded. Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of these claims.

II. The 35 U.S.C. § 102(b) rejection

Hochberg pertains to combination coating-writing heads used in printing systems wherein energy (e.g., electric current, heat, light) is applied to a reactive coating on a print medium such as paper to form marks thereon. For purposes of the rejection, the examiner focuses on the embodiment illustrated in Figures 2A and 2B. The subject printing head 30 includes a series of wires 40 associated with a common electrode 42 for applying electric currents to coated paper, and a plurality of orifices 44 in communication with a plenum chamber 46 containing a pressurized aerosol mist solution for coating the paper immediately prior to the marking operation. As implied by the depictions of the printing head 30 in Figures 2A and 2B, the wires 40, electrode 42 and orifices 44 ostensibly lie on a surface of the printing head which is concavely configured to complement the convex surface of a roller 22 backing the paper.

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Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

As indicated above, independent claim 1 requires a field applier which forms an equipotential surface convexed with respect to the liquid surface of a conductive liquid to be sprayed on an object. The examiner (see page 6 in the answer) considers that (1) Hochberg's wires 40 and electrode 42 constitute such a field applier and (2) the concave surface of Hochberg's printing head 30 embodies such an equipotential surface. These conclusions stem from an assessment that the body of the printing head consists of a homogenous conductive material as evidenced by the manner in which the printing head is cross-hatched in the drawings.

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Notwithstanding the cross-hatching in the drawings, a fair reading of Hochberg clearly indicates that the body of printing head 30 is not made of a homogenous conductive material as asserted by the examiner. If the body were made of such a material, the wires 40 and electrode 42 would not function in the manner disclosed to mark the coated paper. Thus, the examiner's determination that wires 40 and electrode 42 constitute a field applier which forms an equipotential surface as recited in claim 1 rests on a faulty factual finding. Hochberg simply does not convey enough information about the printing head 30 to ascertain its structural make-up. Hence, any conjecture stemming from the supposed construction of the head as to an equipotential surface formed by wires 40 and electrode 42 would be unduly speculative.

Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claim 1, and dependent claims 2 and 3, as being anticipated by Hochberg.

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SUMMARY


The decision of the examiner to reject claims 1-3 is reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

WILLIAM F. PATE, III
Administrative Patent Judge

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JOHN P. McQUADE
Administrative Patent Judge

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